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3661

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application for )  
)  
U.S. Patent No. 5,870,527 issued February 9, 1999 )  
)  
Inventors: TAKAYUKI FUJIKAWA ET AL. )  
)  
Reissue No. 09/775,548 )  
)  
Title: ROBOT CONTROL METHODS AND )  
APPARATUS )

Group Art Unit: 3661

Examiner: M. MARC

RECEIVED  
NOV 25 2002  
GROUP 3600

Transmitted herewith is an amendment in the above-identified application.

☒ No additional fee is required.

The fee has been calculated as shown below

CLAIMS AS AMENDED						
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL CLAIMS	18	MINUS	20	=0	x \$9 \$18	\$
INDEP. CLAIMS	11	MINUS	11	=0	x \$42 \$84	\$
Fee for Multiple Dependent Claims \$130/\$260						
			TOTAL ADDITIONAL FEE FOR THIS AMEND-MENT		\$	

- If the entry in Column 2 is less than the entry in Column 4,
- write "0" in Column 5.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

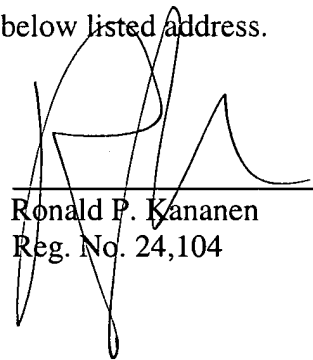
\*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

- ☐ A Letter to the Official Draftsperson is enclosed.
- ☐ A Change of Address is enclosed.
- ☐ Charge \$ to Deposit Account No. 18-0013. A duplicate copy of this sheet is enclosed.
- ☒ Any prior general authorization to charge an issue fee under 37 C.F.R. 1.18 to Deposit Account No. 18-0013 is hereby revoked. The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 and 1.17 which may be required during the entire pendency of this application, or to credit any overpayment, to Deposit Account No. 18-0013. A duplicate copy of this sheet is enclosed.
- ☐ Charge \$\_\_\_\_\_ to Deposit Account No. 18-0013 to cover the Extension fee for response within \_\_\_\_\_ month(s).
- ☒ Applicant's undersigned attorney may be reached by telephone in our Washington D.C. Office at

(202) 955-3750.

All correspondence should be directed to our below listed address.

Date: November 20, 2002

  
\_\_\_\_\_  
Ronald P. Kananen  
Reg. No. 24,104

RADER, FISHMAN & GRAUER PLLC  
1233 20<sup>TH</sup> Street, NW  
Suite 501  
Washington, DC 20036  
Telephone: (202) 955-3750  
Facsimile: (202) 955-3751  
Customer No. 23353



SON-995/REISSUE

BOX AF  
REISSUE APPLICATION

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*Reg for*  
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*Coper*  
*12-3-02*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Reissue Application for )  
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U.S. Patent No. 5,870,527 issued February 9, 1999 )  
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Group Art Unit: 3661

Examiner: M. MARC

**RESPONSE TO FINAL OFFICE ACTION**

COMMISSIONER FOR PATENTS

Box AF

Washington, D.C. 20231

Sir:

This is in full and timely response to the final Office Action dated August 26, 2002 (Paper No. 9). Reconsideration and withdrawal of the rejection stated in the final Office Action are respectfully requested pursuant to 37 CFR 1.116 in view of the following remarks.

Claims 7 to 12 and 14 to 18 stand rejected under 35 U.S.C. 251 as allegedly "being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based." The Examiner cited three court cases in support of this rejection, but did not otherwise explain the basis for the rejection.

On page 3, first paragraph, of the Office Action, the Examiner quoted several phrases which appear to have been taken from the Applicants' remarks in the prior Amendment filed on June 12, 2002. The Examiner then states that these quoted phrases find support on page 3, third paragraph, of the Applicants' Amendment, which states:

The pending reissue claims 7 to 12 and 14 to 18 are materially broader than claims 1 to 5 of the '527 patent on which this reissue application is based.

While the Examiner appears to acknowledge that the subject reissue claims also include narrowing limitations, the Examiner states that such limitations "did not serve to materially narrow the claims in a manner effective to avoid a recapture bar." The Applicants' respectfully disagree.

Section 1412.02 of the Manual of Patent Examining Procedure (8th ed.) ("the M.P.E.P.") sets forth relevant guidelines for the Examiner to follow in considering the recapture rule under 35 U.S.C. 251 in the present reissue application. This section of the M.P.E.P. includes a subheading to guide the Examiner where the "REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME ASPECTS, BUT NARROWER IN OTHERS." This subsection states in relevant part:

If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture.

In the present case, at least part of the broadening aspects of the reissue claims 7 to 12 and 14 to 18 relate to subject matter previously surrendered (i.e., the self-operational arc limitations). However, the Examiner cannot end his analysis of the recapture rule with this determination because the claims also include narrowing limitations. As such, the Examiner must determine whether the newly added narrowing limitations in the reissue claims “modify the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter.” It is respectfully submitted that the Examiner failed to include this step in his analysis, and that the rejections based on the recapture rule should therefore be reconsidered and withdrawn.

The reissue claims 7 to 12 and 14 to 18 are different from the canceled or surrendered claims in the parent application because they include additional narrowing limitations that make the claims allowable. For example, claim 7 recites, among other things, the program step of “selecting one operation based on a predetermined probability from among operations described in an operation state model that describes operational states of said robot.” This program step is not included among the subject matter surrendered in the ‘527 patent and is believed to be an allowable limitation of the claim. Similar narrowing limitations are also included in claims 8 to 12 and 14 to 18, which are believed to define over the prior art and were not included in the surrendered claims of the ‘527 patent, as explained on pages 4 to 7 of the Applicants’ prior Amendment filed on June 14, 2002.

The narrowing limitations added to the pending reissue claims patentably distinguish over the Searji and Rodriguez et al. references cited during the original prosecution of the ‘527 patent, as explained on pages 6 and 7 of the Amendment filed on June 12, 2002. Thus, it is submitted that these narrowing limitations have a material aspect to them, and that the limitations are not incidental, mere verbiage, or inherent in

the canceled or surrendered claims. The Applicants are not recapturing surrendered subject matter, as stated by the Examiner. Instead, the Applicants are presenting the Examiner with materially narrower claims than the claims that were canceled or surrendered during the prosecution of the '527 patent. The recapture rule should not prohibit such materially narrower claims in this reissue application.

The present case is similar to prior court cases in which no violation of the recapture rule was found. For example, in In re Richman, 409 F.2d 269 (C.C.P.A. 1969), a limitation added to a claim to obtain its allowance turned out to be more restrictive than the prior art required. The applicant sought a reissue to broaden the added limitation, and the court found that the broadened reissue claims were allowable. The court reasoned that the applicant was not seeking to recapture the same subject matter sought in the canceled claims because the reissue claims were more restrictive in at least one significant respect than the canceled claims. As such, the court held that the recapture rule does not apply. Id.

Similarly, in Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed. Cir. 1984), the reissue claim was narrower than the canceled claims in an aspect relating to a prior art rejection, and broader in an aspect unrelated to the rejection. The court allowed the reissue claim because the patentee was not attempting to recapture surrendered subject matter. Id. In Whittaker Corp. v. UNR Industries, Inc., 911 F.2d 709, 15 USPQ2d 1742 (Fed. Cir. 1990), the court held that a claim added to a patent during reissue is not invalid under the recapture rule when it contains a limitation making it narrower in scope than a similar claim that was canceled during the original prosecution.

These cited cases are similar to the present case where the Applicants are presenting claims that are materially narrower in scope than the surrendered claims in the

parent application. The Applicants are not trying to recapture the same claims that were canceled or surrendered during the original prosecution.

The present case is different from the prior court cases cited by the Examiner in support of the recapture rule. For example, the reissue claims in In re Clement were materially broader, and only incidentally narrower, to the claims surrendered during the prosecution. 131 F.3d 1464, 1471, 45 USPQ2d 1161, 1165 (Fed. Cir. 1997). The reissue claims in In re Clement were broadened by removing limitations that directly related to several prior art rejections made during the prosecution. Id. Clement, however, did not add any narrowing limitations having a material aspect that would avoid the prior art rejections and that had not been considered before. The only narrowing limitation in the reissue claim of Clement was a limitation that had previously been added in another claim in an effort to overcome a prior art rejection. Id. This is different from the present case where the reissue claims have a materially narrowing limitation, not found in any of the surrendered or canceled claims in the parent application, that patentably distinguishes over the cited references.

The present case is also different from Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472 (Fed. Cir. 1998), which was cited by the Examiner, because there has been no showing that any arguments made during the prosecution of the parent application were sufficient to trigger the recapture rule. In Hester Industries, the court held that surrender of claimed subject matter can occur through arguments alone. 142 F.3d at 1480, 46 USPQ2d at 1648. This holding is not relevant to the present case where the Examiner has not identified any surrendered subject matter in the Applicants' arguments in the parent application.

For at least these reasons, it is respectfully submitted that the M.P.E.P., as well as the prior court cases discussed above, support the Applicants' position that there

Docket No. SON-995/REISSUE  
Serial No. 09/775,548

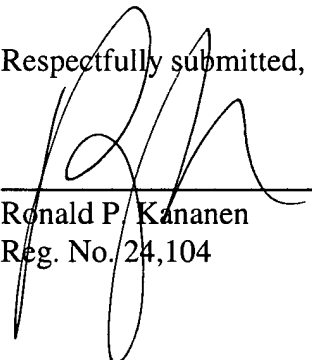
REISSUE APPLICATION

is no improper recapture in the present case. Accordingly, the Examiner is again respectfully requested to reconsider and withdraw the final rejections of claims 7 to 12 and 14 to 18 based on the recapture rule under 35 U.S.C. 251.

If the Examiner has any questions or comments that could place this application into even better form, he is encouraged to contact the Applicants' undersigned representative at the number listed below.

Date: **November 20, 2002**

Respectfully submitted,



---

Ronald P. Kananen  
Reg. No. 24,104

**RADER, FISHMAN & GRAUER P.L.L.C.**  
1233 20th Street, N.W.  
Suite 501  
Washington, D.C. 20036  
Telephone No. (202) 955-2750  
Facsimile No. (202) 955-3751  
Customer No. 23353



PANNU v. STORZ INSTRUMENTS, INC., 258 F.3d 1366 (Fed. Cir. 2001)

JASWANT S. PANNU and JASWANT S. PANNU, M.D., P.A., Plaintiffs-Appellants,  
v. STORZ INSTRUMENTS, INC., Defendant-Appellee.

No. 00-1482.

United States Court of Appeals, Federal Circuit.

Decided July 25, 2001.

Appealed from: United States District Court for the Southern District  
of Florida, Judge William P. Dimitrouleas  
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[EDITORS' NOTE: THIS PAGE CONTAINED HEADNOTES AND HEADNOTES ARE NOT AN  
OFFICIAL PRODUCT OF THE COURT, THEREFORE THEY ARE NOT DISPLAYED.]  
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Michael C. Cesarano, Akerman, Senterfitt & Eidson, P.A., of Miami,  
Florida, argued for plaintiffs-appellants.

Edward W. Remus, McAndrews, Held & Malloy, Ltd., of Chicago, Illinois,  
argued for defendant-appellee. With him on the brief was Jonathan R.  
Sick. Of counsel on the brief were Craig E. Larson, Bausch & Lomb,  
Incorporated, of Rochester, New York; and Rita D. Vacca, Bausch & Lomb  
Surgical, Inc., of St. Louis, Missouri.

Before MAYER, Chief Judge, FRIEDMAN, Senior Circuit Judge, and  
RADER, Circuit Judge.

MAYER, Chief Judge.

Jaswant S. Pannu> and Jaswant S. <Pannu>, M.D., P.A. (collectively <Pannu>)  
appeal the judgment of the United States District Court for the Southern  
District of Florida, <Pannu> v. Storz Instruments, Inc., 106 F. Supp.2d 1304  
(S.D.Fla. 2000), granting summary judgment for Storz Instruments, Inc.  
(Storz) that U.S. Patent No. Re 32,525 is invalid under  
35 U.S.C. § 251, the recapture rule. Because the reissued patent  
improperly broadened claims in a manner directly pertinent to subject  
matter surrendered during prosecution, we affirm.

#### Background

In 1980, <Pannu> filed a patent application for an artificial intraocular  
lens, S/N 136,243 ('243 application). An intraocular lens is an  
artificial plastic lens that may be implanted in an eye to replace a  
natural lens. The '243 application disclosed a round lens called an  
"optic" that focuses light on the retina, and two or more elements called  
"haptics" that are attached to the optic and contact internal tissue in  
the eye for the purpose of positioning and securing the optic. The  
haptics in <Pannu>'s application included "snag resistant" discs at the  
end. In 1981, <Pannu> filed a continuation-in-part application, S/N 261,953  
( '953 application), based on the original '243 application. The '953  
application added new matter, claiming a lens in which the haptics are  
"integrally molded" to the lens body, and the lens could be placed in  
either the anterior or posterior chamber of the eye.HH The eye is  
considered to have two chambers separated by the iris. The anterior  
chamber lies between the back surface of the cornea and front surface of  
the iris. Attorneys' Dictionary of Medicine and Word Finder A-280  
(1995). The posterior chamber is the space between the back surface of

• the iris and the front surface of the crystalline lens. Id. at P-280.

Independent claim 1 of the '953 application reads as follows:

A posterior chamber intraocular lens comprising:

a lens having a width and a thickness;

a retention loop including a flexible strand having a width and a thickness and such strand is joined at one end to the lens and has an opposite free end;

and a snag resistant disc joined to the flexible strand's free end;

said snag resistant disc having a width which is at least 3 times

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greater than the thickness of the disc, at least 3 times greater than the width of the flexible strand, and at least 1/5 as great as the width of the lens for smoothly guiding the free end of the flexible strand across an inner edge of an iris when moving said strand into and out of a posterior chamber of an eye;

said snag resistant disc lying in a plane sufficiently close to a plane of the lens so that both the disc and lens can fit into a posterior chamber behind an eye's iris.

The examiner rejected claims 1-14 as obvious under 35 U.S.C. § 103 in light of four prior art references: U.S. Patent No. 4,159,546 (Shearing patent), a publication showing the "Lindstrom Centrex" lens, U.S. Patent No. 4,249,271 (Poler patent), and U.S. Patent No. 4,092,743 (Kelman patent). In response, <Pannu> filed a supplemental amendment that cancelled claims 1-7 and 10-14, added new claims 16-22, and modified claims 8 and 9 to be dependent upon claim 16. Independent claim 16 reads as follows:

An intraocular lens comprising:

a lens body;

at least two flexible positioning and supporting elements integrally formed with said lens body and extending from the periphery of said lens body;

said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference; and

snag resistant means integrally formed on the free end of said elements for smoothly guiding the lens across eye tissue when implanting the lens.

<Pannu> raised six arguments for the patentability of claim 16 over the four prior art references, including the distinction of "a continuous substantially circular arc having a diameter greater than the diameter of the lens body . . . which significantly enhance the easy insertibility of applicant's lens and significantly reduce any possibility of snagging delicate eye tissue." The examiner accepted <Pannu>'s arguments, and allowed claim 16 subject to minor amendments to set forth precisely the structural details of the haptics. Claim 16 issued as claim 1 of U.S. Patent No. 4,435,855 ('855 patent) and reads as follows:

An intraocular lens comprising:

a lens body;

at least two spaced flexible positioning and supporting elements integrally formed with said lens body as a one piece construction and extending radially outward from the periphery of said lens body;

said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end spaced from said periphery; and

snag resistant means integrally formed on the free end of said elements for smoothly guiding and positioning the lens across contacted eye tissue when implanting the lens,

said snag resistant means having an uninterrupted continuously smoothly curved outer periphery which merges with said free end and is substantially greater in size than the width of said flexible elements.

In 1985, <Pannu> filed an application for reissue of the '855 patent. The supplemental reissue oath stated that <Pannu> "unduly and without deceptive intent narrowed the claims beyond what was necessitated

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by the applied prior art by describing the shape of the outwardly extending elements as defining 'a continuous, substantially circular arc having a diameter greater than the diameter of the lens body.'" The examiner allowed <Pannu> to delete "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end" from claim 1. However, the examiner required <Pannu> to insert additional limitations into the last section of the claim. The last section of claim 1 reads as follows with italics indicating additions and bracketing indicating deletions:

said snag resistant means having an uninterrupted, continuously smoothly curved outer periphery which merges with said free end and is [substantially] at least three times greater in [size] width than the width of said flexible elements, said snag resistant elements and said positioning and supporting elements being substantially coplanar.

The '855 patent reissued as U.S. Patent No. Re 32,525 ('525 reissue).

<Pannu> filed suit against Storz, alleging that intraocular lenses sold by Storz infringed the '525 reissue. Storz filed a counterclaim seeking a declaratory judgment of patent invalidity, and moved for summary judgment that the '525 reissue improperly recaptures subject matter <Pannu> surrendered in obtaining allowance of claim 1 of the '855 patent. The court granted Storz's motion for summary judgment of invalidity and <Pannu> appeals.

#### Discussion

"We review a district court's grant of summary judgment de novo." Vanmoor v. Wal-Mart Stores, Inc., 201 F.3d 1363, 1365, 53 USPQ2d 1377, 1378 (Fed. Cir. 2000). Determining whether the claims of a reissued patent violate 35 U.S.C. § 251 is a question of law, which we review de novo. In re Clement, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163 (Fed. Cir. 1997); Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). This legal conclusion can involve underlying

findings of fact, which are reviewed for substantial evidence. Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998); Mentor, 998 F.2d at 994, 27 USPQ2d at 1524 (citing Ball Corp. v. United States, 729 F.2d 1429, 1439, 221 USPQ 289, 297 (Fed. Cir. 1984)). However, summary judgment is appropriate only when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. Vanmoor, 201 F.3d at 1365, 53 USPQ2d at 1378. The underlying facts in this case are taken directly from the prosecution file histories and the claims of the '855 patent and the '525 reissue, and are not disputed. See Hester, 142 F.3d at 1484, 46 USPQ2d at 1651. Claim construction is a purely legal question, Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1174 (Fed. Cir. 1998) (en banc), and therefore, comparison of the claims of the '855 patent and the '525 reissue is a purely legal question appropriate for summary judgment, Westvaco Corp. v. Int'l Paper Co., 991 F.2d 735, 741, 26 USPQ2d 1353, 1358 (Fed. Cir. 1993) ("A determination of whether the scope of a reissue claim is identical with the scope of the original claim is a question of law, which we review de novo.").

The recapture rule "prevents a patentee from regaining through reissue  
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the subject matter that he surrendered in an effort to obtain allowance of the original claims." Clement, 131 F.3d at 1468, 45 USPQ2d at 1164. Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. Id. (quoting Mentor, 998 F.2d at 996, 27 USPQ2d at 1525). Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." Id. "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." Id. Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; Clement, 131 F.3d at 1470, 45 USPQ2d at 1165.

With respect to the shape of the haptics, claim 1 of the '525 reissue is broader than claim 1 of the original '855 patent. Claim 1 of the '855 patent limited the haptics to "a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Claim 1 of the '525 reissue eliminated this limitation on the shape of the haptics. "A reissue claim that does not include a limitation present in the original patent claims is broader in that respect." Hester, 142 F.3d at 1480, 46 USPQ2d at 1648. In addition, <Pannu>'s reissue oath admitted that he unnecessarily narrowed the scope of the claim with respect to the shape of the haptics. He stated that "the [haptics] may actually be of any shape as long as the elements terminate in a free end having snag resistant means as now recited in claim 1." Correction of <Pannu>'s unnecessary narrowing of claim 1 must involve a corresponding broadening of the reissued claim.

<Pannu> argues that even if the reissued claim is broader, it did not relate to subject matter surrendered during prosecution. This argument is without merit. As originally filed, none of the claims in the '953 application limited the shape of the haptics. The examiner rejected claims 1-14 as obvious. In response to the rejection, <Pannu> filed a supplemental amendment canceling claim 1 and adding new independent claim 16. Claim 16 described the haptics as "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." <Pannu> argued to the examiner, "no such particular shape is disclosed by the lenses of either Shearing or Lindstrom. In fact, Shearing teaches away from the concept of a continuous substantially circular arc supporting strand . . . [and] the Lindstrom lens illustrates a supporting strand with a somewhat irregular, elliptical shape." The addition of the "continuous, substantially circular arc" limitation to claim 16 and the statements made by <Pannu> to the examiner during prosecution of the '855 patent

- limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc. See Southwall Tech., Inc. v. Cardinal AG Co., 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676 (1995). The shape of the haptics was broadened during reissue and was the same subject matter that was surrendered during prosecution.

<Pannu> argues, however, that because the reissued claims were materially narrowed in other respects, the '525 reissue

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avoids the recapture rule. See Hester, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; Clement, 131 F.3d at 1470, 45 USPQ2d at 1165; Mentor, 998 F.2d at 996, 27 USPQ2d at 1525. Instead of being "substantially greater" than the width of the haptics, the snag resistant means must now be "at least three times greater" than the width of the haptics. In addition, the snag resistant means must now be "substantially coplanar" with the haptics.

<Pannu> argues that both modifications relate to the configuration of the haptics, and therefore, what is gained by the elimination of one limitation is given up by the addition of the other limitations.

The "continuous, substantially circular arc" limitation related to the shape of the haptics. The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening. Furthermore, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." Anderson v. Int'l Eng'g & Mfg., Inc., 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634 (Fed. Cir. 1998); see also Mentor, 998 F.2d at 996, 27 USPQ2d at 1525 ("[I]n this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up."). In prosecuting the '855 patent, <Pannu> specifically limited the shape of the haptics to a "continuous, substantially circular arc." On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections.

#### Conclusion

Accordingly, we affirm the judgment of the United States District Court for the Southern District of Florida.

AFFIRMED